

REMARKS

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding objections and rejections in view of the foregoing amendments and the following remarks.

Claims 1 and 3-25 are pending, with Claims 1 and 14 being independent. Claim 2 has been cancelled without prejudice to or disclaimer of the subject matter contained therein. Claims 1, 3, 4, 6, 9, and 11-13 have been amended. In addition, Claims 14-25 are newly added.

The title has been objected to as not being descriptive of the claimed invention. In response, while not conceding the propriety of the objection, the title has been amended. Applicants submit that as amended, the new title is even more clearly indicative of the claimed invention.

The Examiner has construed the claims reciting “means plus function” language as not invoking 35 U.S.C. § 112, sixth paragraph, and requires Applicants to make a formal statement on the record identifying the portions of the specification that recite the structure related to each means+function recitation. While Applicants object to this requirement inasmuch as they are aware of no legal provision requiring such a position, solely to advance the prosecution and for the Examiner’s convenience, Applicants provide below a table showing the correspondence between claimed elements recited in “means plus function” format and elements disclosed in the specification. It should be understood that the claimed means are not limited to the elements in the specification described in this table.

Recitation in Claim	Corresponding Portion in the Specification
a sheet stacking means	a processing tray 129 (lines 12-13 of page 29)
a sheet processing means	a stapler unit 132 (lines 4-5 of page 26); punch unit (lines 14-17 of page 32); alignment plates 144a and 144b (lines 6-8 of page 32);
sheet conveying means	an oscillation roller pair 127 (lines 13-21 of page 40)
control means	CPU circuit portion 200 (page 23, line 22 - page 25, line 6)
image forming means	drum 114 (page 22, lines 16-18)
moving means	return roller 130 (page 32, line 6)

In addition, while the claimed sheet holding portion is not recited in means plus function format, for the Examiner's convenience, Applicants note that this term corresponds, but is not limited to the buffer unit 140 discussed, for example, at lines 11-13 of page 26 of the specification.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of co-pending application no. 10/790,001.

In response, while not conceding the propriety of the rejection, independent Claim 1 has been amended. Applicants submit that as amended, independent Claim 1 is allowable over co-pending application no. 10/790,001 for the following reasons.

Independent Claim 1 relates to a sheet processing apparatus comprising sheet stacking means for stacking sheets, a sheet holding portion which stores supplied sheets, and sheet conveying means.

Claim 1 has been amended to recite sheet processing means for processing the sheets stacked on the sheet stacking means. Claim 1 has also been amended to recite that the sheet holding portion stores supplied sheets while preceding sheets stacked on the sheet stacking means are processed by the sheet processing means. Claim 1 has been further amended to recite that the sheet conveying means is for conveying the sheets stored in the sheet holding portion to the sheet stacking means.

Claim 1 has also been amended to recite that the supplied sheets are held in the sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion.

Finally, Claim 1 has been amended to recite that the stored sheets are discharged to the sheet stacking means from the sheet holding portion by the sheet conveying means when a downstream edge in the conveying direction of a sheet to be supplied last has preceded the downstream edges in the conveying direction of the sheets held in the sheet holding portion by a predetermined amount.

In contrast, Claims 1-13 of co-pending application no. 10/790,001 are not understood to disclose or suggest at least that the supplied sheets are held in the sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion, as recited by amended Claim 1. As a result, the Patent Office is not understood to have satisfied its burden of proof to establish a provisional prima

facie case of obviousness-type double patenting against amended Claim 1, since Claims 1-13 of co-pending application no. 10/790,001 are not understood to disclose or suggest at least one feature of amended Claim 1, and MPEP § 2142 requires the cited art to disclose or suggest *all* the claimed features.¹ For this reason, Applicants respectfully request that the Examiner withdraw the provisional obviousness-type double patenting rejection over Claims 1-13 of co-pending application no. 10/790,001. And since independent Claim 14 is a corresponding non-means-plus-function claim, it is allowable for corresponding reasons over Claims 1-13 of co-pending application no. 10/790,001.

In addition, the Examiner holds that Claims 1-13 are directed to an invention that is not patentably distinct from Claims 1-13 of co-pending application no. 10/790,001, which could form the basis of a rejection under 35 U.S.C. § 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. § 102(e), (f), or (g) and the conflicting claims were not commonly owned at the time the invention of this application was made. The Examiner indicates that this issue can be resolved by a showing that the conflicting inventions were commonly owned at the time the invention of this application was made or by naming the prior inventor of the conflicting subject matter.

In response, Applicants submit that amended Claim 1 is patentably distinct from Claims 1-13 of co-pending application no. 10/790,001 for the reasons noted above in the discussion of

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The requirements for establishing a prima facie case of obviousness of MPEP § 2142 are understood to apply to obviousness-type double patenting rejections, since according to MPEP § 804, a “double patenting rejection of the obviousness-type is ‘analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103’...,” and therefore “....any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination”.

the provisional rejection under the judicially created doctrine of obviousness-type double patenting. Therefore, Applicants submit that a rejection under 35 U.S.C. § 103(a) over co-pending application no. 10/790,001 would not be proper.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by either Uto et al. (U.S. Patent No. 5,112,034) or Kawano et al. (U.S. Patent No. 5,765,824).

In response, while not conceding the propriety of the rejection, independent Claim 1 has been amended. Applicants submit that as amended, independent Claim 1 is allowable over these patents for the following reasons.

As noted above, Claim 1 has been amended to recite, in part, that the supplied sheets are held in the sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion.

In contrast, the patents to Uto et al. and Kawano et al. are not understood to disclose or suggest that supplied sheets are held in a sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion, as recited by amended Claim 1.

Rather, the patent to Uto et al. is merely understood to relate to a finisher unit 500 that conveys sheets, switches sheets between first and second stapling paths 53 and 54, and discharges the sheets so that a sheet from one path is laid on a sheet from the other path. More specifically, this patent is understood to disclose that after the cycle of original documents, as discussed at column 8, line 18 through column 9, line 15, the sheet S1 is introduced into the sheet entrance 6 of the finisher unit, deflected by the entrance deflector 27, forwarded to the second stapling path 54 by the second deflector 52, and pinched by transport rollers 55. When the sensor

40 detects the front end or rear end of the sheet S1, the transport counter 1 is started. When the count of a transport counter 1 reaches a predetermined value, i.e., when the front end of a sheet S1 reaches a predetermined position at the upstream side of paired discharge rollers 41, a step S204 turns off an electromagnetic clutch 55a of the driving system, thereby terminating the rotation of paired transport rollers 55, so that the sheet S1 remains in the second stapling path 54 (as shown at point D in FIG. 10). Next, a dropping operation is performed by retracting stopper 22 from the upper face of the processing tray 12a, transporting the bundle of sheets $F_1 - F_n$ therefrom by transport rollers 56, and moving the stopper 22 to emerge on the tray 12a. Then, the next sheet S2 is transported to the first stapling path 53a by the second deflector and forwarded to the transport rollers 39. When the sensor 40 detects the front end of the sheet S2, the transport counter 2 is started, and the count is increased when the front end of the sheet S2 is pinched between the discharge rollers 41. At the same time, the transport rollers 55 are activated so that the sheet S1 supported by the rollers 55 is transported to the discharge rollers 41, so that the sheet S2 and the sheet S1 are superposed thereunder, are pinched and transported by the rollers 41, and are simultaneously discharged onto the processing tray 12a. But there is not understood to be a disclosure of holding supplied sheets in a sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion, as recited by amended Claim 1.

The patent to Kawano et al. is understood to merely disclose a sheet finisher in which sheets P are stacked and aligned on an intermediate stacker 22, stapled by a stapler 30, and discharged to a discharging tray 6. More specifically, as discussed at column 7, line 46 through column 8, line 7, in a second conveyance mode, the second switching gate G2 is activated and

opens the entry portion of the third conveyance path 300, the third switching gate G3 is switched so that the second entry path 17 can transport sheets, and the second sheet P2₂ of the set of subsequent sheets P2 is branched from the first entrance path 18 through the paired conveyance rollers 1 and 2 and enters the second entry path 17 located above the path 18. The second sheet P2₂ then passes over the upper surface of the third switching gate G3, is conveyed in sliding contact with the surface of the leading edge portion of the first sheet P2₁, which has been stopped, through the paired conveyance rollers 9 and the path 19, comes into contact with the outer peripheral surface of a roller located near the nipping position of the stopped pair of conveyance rollers 21, and then is stopped and is ready for the next operation. In this situation, the first sheet P2₁ and the second sheet P2₂ are superimposed on each other in the path 19, the leading edge portions of them come into contact with the outer peripheral surface of the roller located near the nipping position of the stopped pair of conveyance rollers 8, and are aligned. But there is not understood to be a disclosure of holding supplied sheets in a sheet holding portion with edges in a conveying direction thereof aligned until the last sheet of the sheets to be stored is supplied in the sheet holding portion, as recited by amended Claim 1.

For these reasons, the patents to Uto et al. and Kawano et al. are not understood to anticipate amended Claim 1. Accordingly, Applicants respectfully request that the rejections of Claim 1 over these patents be withdrawn. And since independent Claim 14 is a corresponding non-means-plus-function claim, it is submitted to be allowable for corresponding reasons.

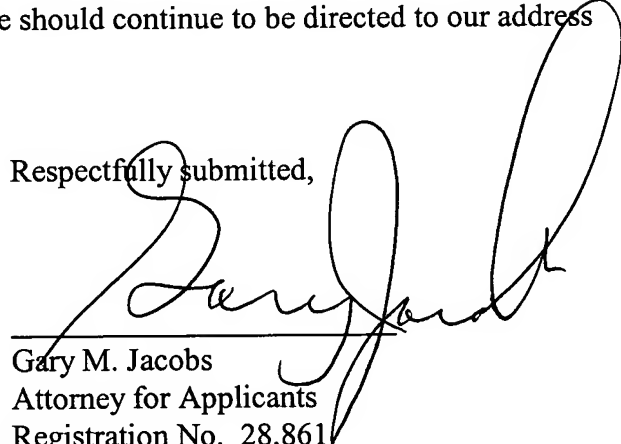
The dependent claims are allowable for the reasons given for the independent claims and because they recite features that are patentable in their own right. Individual consideration of the dependent claims is respectfully solicited.

In view of the above amendments and remarks, the application is now in allowable form.

Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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